

REMARKS

The following remarks are responsive to the Final Office Action dated June 6, 2005. Applicant has not amended the claims. Claims 1, 3-14, 21-73, 80-85, 87-94, 96-104 and 106-111 are pending, with claims 10-14 and 21-73 being withdrawn due to restriction.

Claim Rejection Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected all of Applicant's pending claims (1, 3-14, 21-73, 80-85, 87-94, 96-104 and 106-111) under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,593,426 to Morgan et al. (Morgan). Applicant respectfully traverses the rejection. Morgan and the other cited references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

For example, as acknowledged by the Examiner in both the current and previous Office Actions, Morgan fails to disclose or suggest: a system comprising a two-way communication network that includes a point-of-presence, receives a communication from a remote monitoring service via the point-of-presence and a data network, sends a communication to a portable defibrillator in response to receiving the communication from the remote monitoring service, receives a return communication including a status assessment from the portable defibrillator, and provides the status assessment to the remote monitoring service via the data network, as required by independent claim 1; a system comprising a two-way communication network that includes a point-of-presence, receives a communication that includes a status assessment from a portable defibrillator, and provides the status assessment to a remote monitoring service via the point-of-presence and a data network, as required by independent claim 85; a method comprising providing a status assessment received from a portable defibrillator to a remote monitoring service via a point-of-presence of a two-way communication network and a data network, as required by independent claim 94; and a point-of-presence for a two-way communication network that receives a communication that includes a status assessment from a portable defibrillator, and provides the status assessment to a remote monitoring service via a data network, as required by independent claim 104.

Thus, it appears that the Examiner and Applicant generally agree that there are significant differences between the structure and function of system described by Morgan, and the requirements of Applicant's independent claims. Indeed, the Examiner did not cite any specific teachings within one or more secondary references that would overcome these significant deficiencies in the Morgan disclosure vis-à-vis the requirements of Applicant's independent claims. Nonetheless, the Examiner continued to argue that it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to modify the system described by Morgan to meet the requirements of Applicant's independent claims. More particularly, the Examiner continued to cite seven references as evidence that it was well-known in the art for a medical device and a remote computing device to communicate via a point-of-presence and a data network to easily and inexpensively receive data over a conventional communications systems and allow remote access to data, and that this knowledge would make the modification of Morgan to meet the requirements of Applicant's independent claims obvious. Applicant continues to disagree with this conclusion for the reasons set forth in Applicant's previous Amendment.

In the "Response to Arguments" section of the present Office Action, the Examiner stated that "[t]he arguments that the applicant respectfully disagrees that it would have been obvious to modify Morgan to include a point-of-presence and data network because such features are obvious, that the features of the independent claims do not appear to be well known in the art, and that the examiner has cited no teaching of these features are not persuasive...[because] the examiner cited seven references showing these features, and their use with medical equipment over two way data networks, to show that it is obvious to one having ordinary skill in the art to include these features." This statement mischaracterizes Applicant's arguments in that it suggests that Applicant did not consider or address the references cited by the Examiner. It appears that the Examiner may have misunderstood Applicant's arguments in the prior Amendment. Applicant clarifies and expands upon some of those arguments as follows.

First, the *general* teachings of the use of web servers and data networks to facilitate remote communication with a medical device, found only in *some* of the cited references, would have been insufficient to lead a person of ordinary skill to make the *specific* modifications to the Morgan system necessary to meet to the requirements of Applicant's independent claims. In

other words, the combination of Morgan with the teachings of these other cited references would *still* fail to meet the requirements of Applicant's independent claims with respect to the network structure and functionality recited therein. The Examiner is reminded that, for a prima facie case of obviousness, the combined prior art references must teach or suggest all the claim limitations.¹ If the Examiner believes that the seven references teach or suggest these *specific* features required by Applicant's independent claims, Applicant respectfully requests that the Examiner identify such teachings or suggestions within the references, so that Applicant has an opportunity to address such teachings or suggestions.

For example, none of the cited references teaches or suggests a two-way communication network that includes a point-of-presence, wherein the two-way communication network receives a communication from a remote monitoring service via the point-of-presence and a data network, and sends a communication including an instruction to perform a status assessment of a defibrillator parameter to a portable defibrillator in response to receiving the communication from the remote monitoring service, as required by independent claim 1. The Examiner has cited no teaching within Morgan or the seven other references of these features recited in claim 1 and, accordingly, has failed to address Applicant's arguments.

Additionally, the Examiner has failed to identify any suggestion or motivation within the prior art that would cause a person of ordinary skill to modify Morgan in the manner necessary to arrive at the requirements of Applicant's independent claims, as is required for a prima facie case of obviousness.² Apparently attempting to address the motivation requirement, the Examiner argued that communication via a point-of-presence and a data network allows "easy" and "inexpensive" remote access to data over a conventional communications systems. Applicant fails to see how communication via the Morgan system, modified as suggested by the Examiner, would be any easier or less expensive than communication via the Morgan system as originally described. Accordingly, Applicant fails to see why one of ordinary skill would be motivated to modify the Morgan system in the manner suggested by the Examiner.

Further, the Examiner does not indicate where this "motivation" may be found within the prior art. Indeed, this motivation appears to be based on the Examiner's own opinion.

¹ *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

² *Id.*

The Court of Appeals for the Federal Circuit recently addressed the evidentiary standard required to uphold an obviousness rejection.³ Specifically, the Federal Circuit stated: “[the] factual question of motivation is material to patentability, and (can) not be resolved on subjective belief and unknown authority.⁴ This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.⁵ In other words, it is insufficient to merely pull such motivation out of thin air. Unless the Examiner can identify within the references cited by the Examiner the requisite motivation that would have led a person of ordinary skill in the art to modify the teaching of Morgan as suggested by the Examiner, the Examiner has not established a *prima facie* case of obviousness.

In summary, the Examiner’s conclusion of obviousness with respect to Applicant’s independent claims 1, 85, 94 and 104, and particularly the cited motivation to modify Morgan, is unsupported by any substantial evidence in the record.

Further, claims 5, 88, 97 and 107 recite the systems and method of the independent claims discussed above, and further require that the two-way communication network include a two-way paging network. In the present Office Action, the Examiner again acknowledged that Morgan fails to disclose or suggest this feature of Applicant’s claims, but again concluded that it would have been an obvious design choice for one of ordinary skill in the art at the time of Applicant’s invention to modify system described by Morgan to include a two-way paging network in view of the teachings of two-way paging networks for communication with medical devices in two other cited references.

As stated in Applicant’s previous response, the mere fact that two-way paging systems existed at the time of the invention does not itself provide evidence of a motivation to modify the system described Morgan to include such a network, or any indication as to whether those skilled in the reasonably expect such a modification to successful, as is required for a *prima facie* case of obviousness.⁶ Nor has the Examiner cited any evidence in the prior art supporting the assertion that modification of the Morgan system to include a two way paging network would be an obvious design choice.

³ *In re Lee*, 61 USPQ2d 1430 (CAFC 2002).

⁴ *Id.* at 1434.

⁵ *Id.*

⁶ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In response to these arguments, the Examiner pointed to the following from the prior Office Action:

[It would have been an obvious design choice to modify the system described by Morgan to such that the communication system was a two way paging system]...because Applicant has not disclosed that the communication network being a two way paging network...provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention [sic] to perform equally well with two way communication system using telephone, cellular or RF signal carriers with a point of presence on a data network as taught by Morgan in view of one having ordinary skill in the art, because they provide a two way communication system that uses existing networks to easily and inexpensively transfer data.

Applicant respectfully suggests that this line of argumentation is flawed in several respects.

First, Applicant's disclosure with respect to a two way paging network is irrelevant to the obviousness analysis, at least until a *prima facie* case of obviousness has been made. In other words, until the Examiner establishes a *prima facie* case of obviousness, the burden of demonstrating nonobviousness does not shift to Applicant. Contrary to the Examiner's arguments, Applicant's disclosure is *not* relevant to the determination of whether one of ordinary skill would have been motivated to modify the Morgan system to include a two way paging network. As discussed above, the Federal Circuit clearly stated that the motivation for modification of a primary reference must be found *in the prior art*. For this reason, it is also completely irrelevant to the obviousness analysis whether one of ordinary skill "would have expected Applicant's invention to perform equally well using telephone, cellular or RF signal carriers with a point of presence on a data network."

What is relevant to the obviousness analysis is whether there is any teaching or suggestion *within the prior art* of a motivation to modify the Morgan disclosure as suggested by the Examiner, and whether there is any teaching or suggestion *within the prior art* that one of ordinary skill would have expected such modification to be successful. The Examiner has cited no evidence *from the prior art* demonstrating that those of ordinary skill in the art would consider a two way paging network to be an obvious design choice, particularly in the context of the other requirements of Applicant's claims. Further, for the reasons discussed above, the Examiner's reference to a two way paging network as being "easy" and "inexpensive" is wholly inadequate as a motivation. Indeed, the Examiner has not even provided evidence from the prior

art that would support the conclusion that, prior to Applicant's disclosure, a person of ordinary skill in the art would have considered a two way paging network as being "easy" or "inexpensive" relative to another network or technique.

Moreover, as stated in Applicant's previous Amendment, upon reading the Morgan disclosure, one of ordinary skill in the art at the time of the invention would have recognized that substitution of a two-way paging network for the communication link between a defibrillator communicator and communication station in the system described by Morgan, as suggested by the Examiner, would actually frustrate the ability of such devices to exchange data, such as ECG data, in real time during a medical emergency as taught by Morgan.⁷ Consequently, one of ordinary skill would have consciously avoided the modification to the Morgan system proposed by the Examiner, and would clearly not find such a modification to be obvious, irrespective of any teaching or suggestion in the prior art.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's pending claims 1, 3-9 and 80-85, 87-94, 96-104 and 106-111 under 35 U.S.C. 103(a). Withdrawal of these rejections is requested.

CONCLUSION

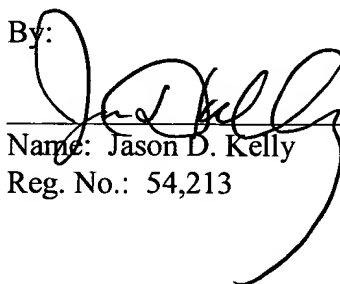
All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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8/12/05

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⁷ Column 4, lines 13-30.